

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TEDDIE G. WATSON and JEFFREY L. ORTH

Appeal No. 1998-3003
Application No. 08/589,621¹

ON BRIEF

Before STAAB, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

¹ Application for patent filed January 22, 1996. According to the appellants, the application is a continuation of Application No. 07/910,635, filed July 8, 1992, now U.S. Patent No. 5,485,697, which was a continuation-in-part of Application No. 07/837,662, filed February 14, 1992, now U.S. Patent No. 5,237,771, which was a continuation of Application No. 07/715,730, filed June 17, 1991, now abandoned, which was a continuation of Application No. 07/587,251, filed September 24, 1990, now abandoned, which was a continuation of Application No. 07/354,917, filed May 22, 1989, now U.S. Patent No. 4,960,437.

Appeal No. 1998-3003
Application No. 08/589,621

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 8, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a fish-attracting sound-generating module. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims under 35 U.S.C. §§ 102 and 103 are:

Dugan, Jr. 1986 (Dugan)	4,583,313	Apr. 22,
Buchanan 1986	4,625,447	Dec. 2,
Fuentes et al. 21, 1989 (Fuentes)	4,805,339	Feb.

The reference relied upon by the examiner in rejecting the appealed claims under obviousness-type double patenting is:

Watson et al. 1990 (Watson)	4,960,437	Oct. 2,
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Claims 1 through 8 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 through 18 of Watson.²

Claims 1, 7 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fuentes.

Claims 2 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fuentes.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fuentes in view of Buchanan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the first Office action

² This rejection is set forth in the supplemental final rejection (Paper No. 9, mailed September 2, 1997). The rejection of claims 1 through 8 under the judicially created doctrine of obviousness-type double patenting over claims 1 through 19 of U.S. Patent No. 5,237,771 made in the first Office action (Paper No. 5, mailed January 16, 1997) is not before us in this appeal since this rejection was not made in the supplemental final rejection.

(Paper No. 5, mailed January 16, 1997), the supplemental final rejection (Paper No. 9, mailed September 2, 1997), and the examiner's answer (Paper No. 12, mailed May 22, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 10, filed January 29, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The double patenting rejection

We will not sustain the rejection of claims 1 through 8 under the judicially created doctrine of obviousness-type double patenting over claims 1 through 18 of Watson.

In evaluating the examiner's position regarding this rejection (supplemental final rejection, pp. 2-4), we are somewhat surprised by the examiner's failure to provide any meaningful comparison of claims 1 through 8 of the present application with patent claims 1 through 18 so as to establish where each of the specific limitations recited in the rejected claims is found in the patent claims and exactly what the differences are between that which is now being claimed and that which was already claimed in the appellants' prior patent.³ In addition, we are struck by the paucity of the examiner's explanation as to how and why the presently claimed subject matter set forth in claims 1 through 8 on appeal is considered unpatentable over the invention as defined in the appellants' prior patent claims 1 through 18.

Like the appellants (brief, pages 3-4), we do not consider that the examiner has met his burden of proof regarding unpatentability of claim 1 through 8 on appeal based

³ A similar rejection was reversed in the parent application.

on obviousness-type double patenting. As for the examiner's bald assertion that

[i]t would have been obvious to one skilled in the art to provide the claims of US 4,960,437 with a printed circuit board with a printed circuit to minimize the size of the device which would enable it to be used on smaller (and therefore more) lures

we find such pontificating to be of no evidential value in establishing obviousness of the appellants' invention as defined in claims 1 through 8 on appeal when considered in light of claims 1 through 18 of the appellants' prior patent. In the final analysis, we find a total failure in the **evidence** to support the examiner's position, and that the examiner's entire approach to this rejection was improper. Accordingly, we will not sustain the examiner's rejection of claims 1 through 8 on appeal based on the judicially created doctrine of obviousness-type double patenting.⁴

The anticipation rejection

⁴ The examiner should consider whether or not claims 1 through 8 should be rejected on the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 5,485,697.

We sustain the rejection of claim 1 under 35 U.S.C. § 102(b) but not the rejection of claims 7 and 8.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 1

The examiner determined (first Office action, p. 3) that claim 1 was anticipated since

[t]he patent to Fuentes shows a fishing lure with a case 11 with a miniaturized IC printed circuit 27 fitted in the case, a battery compartment 25 with replaceable battery means 20, an oscillator means 47, 48 and means 22, 23 for electrically connecting the oscillator means to the printed circuit.

The appellants argue (brief, p. 5) that Fuentes does not disclose "a miniaturized printed circuit board with a printed circuit on the circuit board."

The examiner responded (answer, p. 4) to the appellants' argument stating that "Fuentes shows a circuit board that can be interpreted to be miniaturized by noting the size of the hearing aid batteries in Fig. 2 and the size of the circuit board (also shown in Fig. 2)."

A review of Fuentes reveals, at column 5 lines 23-28, that the electronic circuit mounting board 27 shown in Figure 2 "may comprise a PC board" to which is mounted the various electronic components of the circuitry. In our view, one of

ordinary skill in the art would have readily recognized the "PC board" of Fuentes as including a printed circuit thereon to which the various components seen in Figure 2 are connected upon being mounted on the board.⁵

Fuentes also reveals, at column 4 lines 63-68, that three type 675 hearing aid batteries can be used in a sonic fishing lure having "an overall size of approximately two-to-four inches." In our view, one of ordinary skill in the art would have readily recognized that the claimed "miniaturized" printed circuit board is readable on the PC board of Fuentes.

In view of the above determination, we conclude that Fuentes does disclose "a miniaturized printed circuit board with a printed circuit on the circuit board." Thus, the appellants' argument is not persuasive of error in the

⁵ The Dictionary of Computers, Information Processing & Telecommunications, Second Edition, (1987) defines "printed circuit board (PCB)(PC board)" as "an insulating board onto which a circuit has been printed or etched."

examiner's position regarding claim 1.⁶ Accordingly, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

Claims 7 and 8

The examiner determined (first Office action, pp. 3-4) that claims 7 and 8 were anticipated since

Fuentes shows a securing means 19 and means 19 for connecting a fishing lure opposite the module from the support means a distance from the module.

A user fishing from a boat or tube would function as support means to suspend the module beneath the surface of the water.

The appellants argue (brief, p. 5) that Fuentes does not disclose a "module" "suspended in water beneath support means floating on said water." The appellants assert that the examiner's speculations "concerning how the Fuentes structure might be used are not extractable from the reference."

⁶ We further note that the appellants' brief included no evidence or argument addressing the examiner's position on inherency, but merely incorrectly urged that Fuentes did not disclose "a miniaturized printed circuit board with a printed circuit on the circuit board."

The examiner responded (answer, p. 4) to the appellants' argument stating that "Fuentes shows a securing means 19 with the lure 10 acting as the module" and that the support means "is an angler floating on the surface of the water on a boat."

After review of Fuentes, we conclude that there is no disclosure in Fuentes of "support means floating on said water" from which the fish-attracting, sound-generating "module" or lure 10 therein is suspended beneath in the water. Thus, we agree with the appellants that the examiner's speculations concerning how the Fuentes structure might be used are not extractable from the reference. In that regard, Fuentes does not disclose either (1) an angler floating on the surface of the water on a boat, or (2) a user fishing from a boat or tube to suspend the lure beneath the surface of the water.⁷

⁷ We recognize that Fuentes does disclose that his sonic fishing lure may be used at great depths (column 2, lines 66-68), however, Fuentes does not disclose that such lure is suspended beneath support means (e.g., a boat or tube) floating on the water.

Since all the limitations of claims 7 and 8 are not disclosed in Fuentes for the reasons set forth above, the decision of the examiner to reject claims 7 and 8 under 35 U.S.C. § 102(b) is reversed.⁸

The obviousness rejections

We will not sustain the rejection of claims 2 through 6 under 35 U.S.C. § 103. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to claims 2 through 6.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the

⁸ The examiner should consider whether or not the subject matter of claims 7 and 8 would have been obvious under 35 U.S.C. § 103 over Fuentes and other prior art that establishes that the subject matter of claims 7 and 8 would have been obvious.

reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Claims 2 through 4

The examiner determined (first Office action, pp. 4) that Fuentes does not disclose varying the frequency or duration of the pulses, but it would have been obvious to vary the parameters to tailor the module to different species of fish.

The appellants argue (brief, p. 5) that the examiner "offers nothing in support of the conclusion that 'it would have been obvious to vary the parameters to tailor the module to different species of fish.'"

Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47

USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection.").

In this case, the examiner did not make particular findings regarding the locus of the suggestion, teaching, or motivation to have modified the prior art reference of Fuentes. Thus, we agree with the appellants that there is no

evidence in this rejection to support the examiner's determination of obviousness.⁹ Accordingly, the decision of the examiner to reject claims 2 through 4 under 35 U.S.C. § 103 is reversed.

Claim 5

The examiner determined (first Office action, p. 5) that "it would have been obvious to provide Fuentes with first and second conductors as shown by Buchanan to attract fish."

The appellants argue (brief, p. 6) that Buchanan "does not fairly suggest terminal ends exposed to water and conductive ends coupled to electronic circuitry on a printed circuit board as required by Claim 5."

The examiner responded (answer, pp. 4-5) to the appellants' argument stating that

⁹ Dugan teaches (column 2, lines 47-61) varying the frequency output of a transducer in a fishing lure. The examiner should consider whether or not the subject matter of claims 2 through 4 would have been obvious under 35 U.S.C. § 103 from the combined teachings of Fuentes and Dugan.

it would have been obvious to use the output from the circuit of Fuentes to drive the conductors [20a and 21a of Buchanan] noting that the voltages recited by Buchanan and Fuentes overlap and both are in the range of about 5 volts.

Claim 5 requires (1) first and second conductors to extend exteriorly of the case, (2) each conductor to have a terminal end and a conductive end, and (3) means electrically coupling both conductive ends to the printed circuit. However, these limitations taken together are not suggested by the applied prior art. In that regard, while Buchanan does teach (1) first and second conductors (i.e., leads 20a and 21a) which extend exteriorly of a case (i.e., body 11), (2) each conductor having a terminal end and a conductive end, and (3) means electrically coupling both conductive ends to a circuit (i.e., solar cell 16 which is part of a circuit shown in Figure 5), Buchanan does not teach or suggest connecting the conductive ends to a printed circuit, especially the printed circuit disclosed by Fuentes.

In our view, the only suggestion for modifying Fuentes in the manner proposed by the examiner to meet the above-noted

limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that the decision of the examiner to reject claim 5 under 35 U.S.C. § 103 is reversed.

Claim 6

The examiner determined (first Office action, pp. 5-6) that

"it would have been obvious to provide Fuentes with a piezo electric transducer as shown by Dugan mounted on the outside of the lure to better transmit vibrations." Thereafter, the examiner states that

[i]t in [sic, is] not clear if Fuentes or Dugan employ a choke coil as part of the oscillator circuit but it would have been within the preview [sic, purview] of one skilled in the art to employ one of the old and well known oscillator circuits to drive the piezoelectric transducer.

The appellants argue (brief, p. 6) that claim 6 specifically requires a "choke coil connected to said oscillator means" and that such structure is not taught or suggested by the applied prior art (i.e., Fuentes and Dugan).

The examiner responded (answer, p. 5) to the appellants' argument stating that the electric coil of Fuentes (see column 5, line 62) is not disclosed as a choke coil and it is not clear if the coil is used to change the frequency of the sound. The examiner then stated that

the use of RL circuits and also RC circuits are old and well known (see Dugan in lines 15-20 of column 3 for RC circuits) and it would have been obvious to use an old and well known RLL circuit to change the values of the sound frequency since the function is the same and no showing of unexpected results was made.

We agree with the appellants that the applied prior art (i.e., Fuentes and Dugan) does not teach or suggest use of a "choke coil connected to said oscillator means," as set forth in claim 6. As in the rejections of claims 2 through 4, there is no evidence in this rejection to support the examiner's

determination of obviousness.¹⁰ Accordingly, the decision of the examiner to reject claim 6 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 8 under the judicially created doctrine of obviousness-type double patenting is reversed; the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 7 and 8 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 2 through 6 under 35 U.S.C. § 103 is reversed.

¹⁰ If the use of a choke coil connected to an oscillator means is known in the art as stated by the examiner, the examiner should cite that prior art and then should consider whether or not the subject matter of claim 6 would have been obvious under 35 U.S.C. § 103 from the combined teachings of Fuentes, Dugan and this other prior art.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPEAL NO. 1998-3003 - JUDGE NASE
APPLICATION NO. 08/589,621

APJ NASE

APJ CRAWFORD

APJ STAAB

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 24 May 99

FINAL TYPED: